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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,753	08/02/2006	Vincenzo Di Giorgio	09952.0053	5633
22852	7590	05/20/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER DOAN, PHUOC HUU	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 05/20/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/567,753

**Applicant(s)**

DI GIORGIO ET AL.

**Examiner**

PHUOC DOAN

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37, 38, 40-55 and 57-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37, 38, 40-55, 57-71 and 74 is/are allowed.
- 6) ☒ Claim(s) 72 and 73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 37-38, 40-55, and 57-74 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 72 is rejected under 35 U.S.C. 101 because

As to claim 72, the claimed recites “a computer readable medium” in which the computer program product is embodied on and that without an explicit definition in the specification, it is given its broadest reasonable interpretation, typically covers forms of non-transitory tangible media and transitory propagating signal per se., carrier wave etc, Therefore, the claimed invention is directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 112***

2. Claim 72 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains

subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 72, the claimed recites “a computer readable medium” does not support on the original specification. Where was not existing the term “a computer readable medium”.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dennis (US Patent No: 6,542,733) in view of Rogers (US Patent No: 6,360,108).

**As to claim 73**, Dennis discloses a method for processing user identifiers stored in a terminal for telecommunications networks (See Abstract “Users add telephone number and configure profile information on the wireless device which linked to the wireless network”), comprising:

modifying the user identifiers by including an identification code of an operator selected by a user of the terminal or at least one of a country prefix and a local prefix; selectively organizing said user identifiers in one of a plurality of configurations (page 3, lines 20-40 "allows the user to enter telephone numbers or other information") , said plurality of configurations comprising at least a first and a second configuration (col. 4, lines 5-40 "the personal profile system can be configured so that the user can select special code or long distance service"); and receiving from the user of the terminal information relating to a location of said terminal and the operation of switching said user identifiers between said first configuration and said second configuration following the receipt of the information (col. 4, lines 5-10, col. 5, lines 22-34) , wherein said first configuration comprises the user identifiers organized with the insertion of the identification code of the operator selected by the user of the terminal, wherein said second configuration comprises the user identifiers organized with the inclusion of at least one of the country prefix and the local prefix (col. 4, lines 25-40, col. 5, lines 23-51 "user can select to have a default setting which is stored the number in memory or user could assign special codes of country and a local, for example: 01; 995-555-1234"), and wherein the modified user identifiers

are stored in the terminal (col. 6, lines 15-25). However, Dennis does not disclose a country prefix and a local prefix.

In the same field of endeavor, Rogers discloses a country prefix and a local prefix (See col. 6, TABLE 1 “provided a country prefix and a local prefix”; col. 6, lines 1-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a country prefix and a local prefix as taught by Rogers to the system of Dennis in order to offer the advantage of mobile telephone users when they are traveling.

#### ***Allowable Subject Matter***

4. Claims 37-38, 40-55, 57-71, and 74 are allowed.

#### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUOC DOAN whose telephone number is (571)272-7920. The examiner can normally be reached on 10:00AM to 6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LESTER KINCAID can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PHUOC DOAN/  
Examiner, Art Unit 2617